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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,791	01/07/2004	Paul Q. Anziano	MTGY0001-101	6578
35145	7590	12/16/2005	EXAMINER	
COZEN O' CONNOR, P. C.			HILL, MYRON G	
1900 MARKET STREET			ART UNIT	
PHILADELPHIA, PA 19103-3508			PAPER NUMBER	

1648

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/752,791

Applicant(s)

ANZIANO, PAUL Q.

Examiner

Myron G. Hill

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This action is in response to the paper filed 29 September 2005.

This action is on claims 1-6 and 31-42.

Rejections Withdrawn

Claim Rejections - 35 USC § 112

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 4, 5, and 40 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant has amended the claims.

Rejections Maintained

Art Unit: 1648

Claims 1-6, 31, 33-35, 40, and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

The claims are drawn to nucleic acids with at least 70 or 97% homology to a sequence.

Applicant argues that they have described distinguishing characteristics and described 70% or more (page 9 of the specification).

Applicant's arguments have been fully considered and not found persuasive.

Applicant is claiming a genus of material and has shown one example of the genus. Applicant has not indicated what the distinguishing characteristics are or defined what structure is required. Applicant argues function but function is a property of structure and does not further define the claimed invention. The mere mention of a limitation in the specification does not provide description of the genus claimed.

The rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 1648

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-6, 33, 37, 38, and 40 are rejected under 35 U.S.C. 102(b) as being anticipated by Heckl *et al.* US 5240847.

Applicant argues that the claims recite a specific activity and the prior art fails to teach the limitations of the claims.

Applicant's arguments have been fully considered and not found persuasive.

The prior art has the same structure as required by the claim.

Where, as here, the Patent Office lacks the facilities to perform comparisons between the claimed material and prior art materials that reasonably appear to meet the claim limitations, the burden is properly shifted to applicant to distinguish the claimed product from the prior art product. See *In re Best, Bolton, and Shaw*, 195 USPQ 430 (CCPA 1977); *Ex Parte Gray*, 10 USPQ2nd 1922 (BPAI 1989).

New Rejection

Claims 1-6, 33, 34, and 40 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling SEQ ID#1, does not reasonably provide enablement for sequences with homologies less than 100%. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

Art Unit: 1648

Applicant agrees that the claims do not read on hybridization, and requests further clarification.

Applicant's arguments have been fully considered and found persuasive in part.

The claims are drawn to a SEQ ID# with a functional limitation.

Heckl *et al.* US 5240847 teach a sequence that has the same structure as recited in the claims, Formula IX (columns 21-22) that codes for a sequence that is over 70% to SEQ ID#2 but appears to have a different function.

The specification does not teach what is required of the coding sequence to both have the recited structure and the recited function.

Without additional teachings in the specification, it would require undue experimentation to use the invention as now claimed.

Allowable Subject Matter

Claims 32, 36, 39, and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myron G. Hill whose telephone number is 571-272-0901. The examiner can normally be reached on 8:30 am-5 pm Mon-Fri.

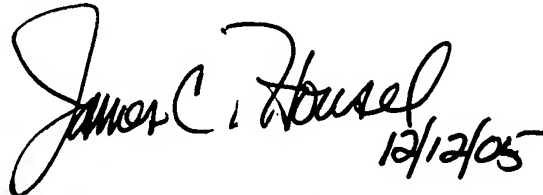
Art Unit: 1648

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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5/25/05



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